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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,929	09/29/2003	Charles Whitaker	020375-032410	2374
20350 7590 01/29/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER RAPILLO, KRISTINE K	
			ART UNIT 3626	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/675,929

Applicant(s)

WHITAKER ET AL.

Examiner

KRISTINE K. RAPILLO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1 – 27 are pending.

#### ***Notice to Applicant***

1. This communication is in response to the amendment filed September 23, 2007. The following has occurred: A typographical error was corrected in paragraph [0043] of the specification; no claims were amended; and, the figures were updated in the drawings (the handwritten reference characters were replaced with typed reference characters). Claims 1 – 27 are presented for examination.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 9, 11 – 12, 14 – 16, and 22 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (U.S. Patent No. 6,012,035) in view of Pritchard (U.S. Patent No. 4,491,725).

As per claim 1, Freeman et al. teaches a method of verifying insurance coverage relating to a member comprising: searching a database to determine if the member identifier is valid (column 7, lines 20 – 25) and transmitting from the financial transaction

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processing computer system authorization information (column 5, lines 14 – 24 and column 7, lines 60 – 63). Freeman et al. discloses a loop system in Figure 1 which illustrates the method of all terminals (i.e. computer systems) having the ability to communicate to each other. Thus, a financial transaction processing computer system can provide authorization information.

Freeman et al. fails to teach receiving a member identifier at a computer system.

Pritchard teaches a method of receiving at a financial transaction processing system a member identifier relating to the member (column 7, lines 20 – 27). Pritchard describes a method in which an insurance card is verified against a master list using a local terminal that can be linked to a central computer (Figure 1). Pritchard also indicates that a service provider (i.e. physician) can contact a financial institution directly, therefore, member identification is performed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a computer processing system in which a member identifier is received as taught by Pritchard with the motivation of ensuring a person/member is covered by a valid insurance policy (column 7, lines 28 – 33).

As per claim 2, Freeman et al. teaches a method wherein the financial transaction processing computer system comprises a credit card processing system (column 7, lines 66 – 67 and column 8, line 1). This is accomplished through a 'swipe' through a credit card type machine.

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Regarding claim 3, Freeman et al. and Pritchard teach a method of verifying insurance via a database search and transmitting authorization information as per claim 1.

Freeman et al. fails to teach a method wherein the member identity number is in credit card number format.

Pritchard teaches a method in which the member identifier is received in credit card number format (column 5, lines 25 – 32 and column 5, lines 67 through column 6, lines 1 – 4). Pritchard describes an invention in which the member is assigned a number, which can be correlated to a credit card number format since credit card numbers are available in various formats.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a member identity number in credit card number format as taught by Pritchard with the motivation of providing more information storage and security (column 5, lines 40 – 66).

As per claim 4, Freeman et al. teaches a method further comprising receiving an individual code at the financial transaction processing computer system (column 5, lines 35 – 39).

Regarding claim 5, Freeman teaches a method as per claim 4, where the individual code is received in a format relating to currency (column 5, lines 35 – 39). Individual codes are available, however, unable to locate a format relating to currency

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specifically, other than for a financial institution. The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Regarding claim 6, Freeman et al. teaches a method as per claim 1, where in the insurance coverage relates to medical insurance (column 6, lines 59 – 62).

Regarding claim 7, Freeman et al. and Pritchard teach a method comprising receiving at the financial transaction processing computer system an identifier relating to a provider (column 5, lines 31 – 35). Freeman et al. discloses a method in which cooperative members are provided identification in order to access a database. The cooperative members consist of buyers and sellers of healthcare products and services including health care providers, employees, employers, insurance companies, and financial organizations.

Regarding claim 8, Freeman et al. teaches a method as per claim 1 further comprising determining whether the provider is a network provider (column 4, lines 47 – 58). A network is described as a group in which various health care providers have agreed to join.

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Regarding claim 9, Freeman et al. and Pritchard teach a method of verifying insurance as per claim 1.

Freeman et al. fails to teach a method indicating a denial of insurance coverage.

Pritchard teaches a method wherein the authorization information indicates a denial of coverage (column 7, lines 26 – 28 and lines 33 – 36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method for rapidly indicating the status of insurance coverage as taught by Pritchard with the motivation of ensuring an individual is covered by a valid insurance policy (column 12, lines 9 – 11).

Regarding claim 11, Freeman et al. teaches a method of verifying insurance coverage relating to a member comprising entering member identifier information into a credit card processing device (column 7, lines 66 – 67 through column 8, line 1) and transmitting information to a host computer system (column 5, lines 14 – 26).

Freeman et al. fails to teach a method of receiving authorization information at a processing device.

Pritchard teaches a method of receiving authorization information at the processing device indicating whether the member has insurance coverage (column 7, lines 20 – 24).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9, and incorporated herein.

Regarding claim 12, Freeman et al. teaches a method as per claim 11 wherein the identifier information comprises an individual code in a currency field (column 5, lines 35 – 39). The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Regarding claim 14, Freeman et al. and Pritchard teach a method of verifying insurance coverage as per claim 11.

Freeman et al. fails to teach a method where authorization can include a denial in insurance coverage.

Pritchard teaches a system wherein the authorization information indicates a denial of coverage (column 7, lines 26 – 28 and lines 33 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

Regarding claim 15, Freeman et al. teaches a method as per claim 1 wherein entering member identifier information comprises swiping an insurance card (column 6, lines 65 – 67).

Regarding claim 16, Freeman et al. teaches a method of swiping an insurance card as per claim 15.



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Freeman et al. fails to teach a method the insurance card is made of credit card stock.

Pritchard teaches a method wherein the insurance card comprises credit card stock (column 5, lines 19 – 22). Pritchard describes a typical credit card, made of credit card stock (i.e. plastic), including a magnetic stripe on the back.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method in which the insurance card is made of credit card stock as taught by Pritchard with the motivation of providing an insurance card with the capability of storing secure information (column 5, lines 40 – 65).

Regarding claim 22, Freeman et al. teaches a system for processing insurance information comprising a credit card processing network (column 6, lines 66 – 67) which can include computer terminals, a host computer system (column 4, lines 26 – 30) and wherein the host computer system is programmed to receive information from a point of sale device via the credit card processing network and verify coverage (column 2, lines 51 – 55 and column 8, lines 1 - 7).

Regarding claim 23, Freeman et al. and Pritchard teach a system as per claim 22, wherein the host computer system is further programmed to determine a dependent's coverage (column 7, lines 20 – 25). The reference describes a method for providing verification of a patient's eligibility. The examiner interprets this to include all

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patients therefore patient eligibility can refer to all members covered by the insurance plan.

Regarding claim 24, Freeman et al. teaches a system as per claim 22 wherein the host computer system is programmed to determine if a provider is a network provider (column 4, lines 47 – 58). A network is described as a group in which various health care providers have agreed to join.

Regarding claim 25, Freeman et al. teaches a system as per claim 22.

Freeman et al. fails to teach the transmittal of an approval code.

Pritchard teaches a system wherein the host computer system is further programmed to transmit an approval code (column 7, lines 26 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

Regarding claim 27, Freeman et al. teaches a system for processing insurance information.

Freeman et al. fails to teach the approval code can be a denial of coverage.

Pritchard teaches a system wherein the approval code comprises a denial of coverage (column 7, lines 26 – 28 and 33 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

3. Claims 10, 13, 19 – 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Pritchard, as applied to claims 1 and 11, and in further view of Doyle et al. (U.S. Patent No. 5,070,452).

Regarding claims 10 and 13, Freeman et al. and Pritchard teach a method of verifying insurance coverage as per claim 1.

Freeman et al. and Pritchard do not teach a system where authorization can signal a co-pay.

Doyle et al. teaches a system wherein the authorization information comprises a co-payment (column 5, lines 54 – 62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system for co-pay authorization as taught by Doyle et al. with the motivation of updating a physicians records and receiving payment at the time of medical service (column 8, lines 64 – 66 and column 9, lines 4 – 7).

Regarding claim 19, Freeman et al. teaches a method of enrolling a member into medical coverage comprising receiving enrollment information from the member (column 5, lines 64 – 67).

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Freeman et al. does not explicitly teach a method of assigning an account number, assigning codes to dependents covered under the insurance, or producing a card for the member.

Pritchard teaches a method of assigning an account to the member wherein the account is in a credit card format (column 5, lines 25 – 32) and producing a card for the member wherein the card comprises credit card stock (column 5, lines 19 – 22).

Pritchard fails to teach a method of assigning codes to dependents covered under the insurance.

Doyle et al. teaches a method of assigning a code to each covered dependent of the member wherein each dependent's code is in currency format (column 4, lines 11 – 16). The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of assigning codes to dependent covered under the insurance plan as taught by Doyle et al. with the motivation of providing identification of the patient in order to assure the actual patient enrolled in the insurance plan is receiving the treatment (column 4, lines 17 – 20).

Regarding claim 20, Freeman et al., Pritchard, and Doyle et al. teach a method of enrolling a member into medical coverage as per claim 1.

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Freeman et al. and Pritchard do not teach a method to produce dependent codes on the insurance card.

Doyle et al. teaches a method as per claim 19 producing dependent codes on the card (column 4, lines 5 – 16). The insurance card includes a client code, which identifies the insurance plan, as well as the relationship to the cardholder.

The motivation of combining the teachings of Freeman et al., Pritchard, and Doyle et al. is discussed in the rejection of claim 19.

Regarding claim 26, Freeman et al. and Pritchard teach a system for processing insurance information as per claim 22.

Freeman et al. and Pritchard do not teach a system where the approval code indicates a co-payment.

Doyle et al. teaches a system wherein the approval code comprises a co-payment (column 5, lines 54 – 62). The examiner interprets 'approval' to be equivalent to 'authorization'.

The motivation of combining the teachings of Freeman et al., Pritchard, and Doyle et al. is discussed in the rejection of claims 10 and 13.

4. Claims 17 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard in view of Doyle et al.

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Regarding claim 17, Pritchard discloses an insurance card comprising an account number in credit card number format (column 5, lines 25 – 32 and column 5, line 67 through column 6, line 4), a machine-readable storage medium (column 6, lines 4 - 7) and wherein the insurance card comprises credit card stock (column 5, lines 19 – 22).

Pritchard fails to teach a list of covered members.

Doyle et al. teaches a list of covered members (column 4, lines 11 – 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a list of covered members as taught by Doyle et al. with the motivation of maintaining a comprehensive roster of all individuals actively covered under an insurance plan, including the types of benefits available (column 2, lines 4 – 10). This allows physicians to view what options for medical service are available for patients based on their insurance plans (i.e. what services are covered).

Regarding claim 18, Pritchard teaches an insurance card as per claim 17 wherein the insurance card relates to medical insurance (column 7, lines 10 – 12).

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Pritchard and Doyle et al., as applied to claim 20, and in further view of Kenna et al. (U.S. Patent No. 6,108,641).

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Regarding claim 21, Freeman et al., Pritchard, and Doyle et al. teach a method of enrolling a member into medical coverage as per claim 19.

Freeman et al., Pritchard, and Doyle et al. do not teach pre-tax spending accounts.

Kenna et al. teaches a method comprising entering pre-tax spending account information relating to the member (column 2, lines 62 – 65 and column 8, lines 56 –59).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include pre-tax spending accounts as taught by Kenna et al. with the motivation of tracking medical expenses and deposits via a link to the medical savings account database, as well as the insurance provider database (column 3, lines 44 – 52).

### ***Response to Arguments***

6. Applicant's arguments filed September 29, 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order they appear in the response filed September 29, 2007.

In regard to claim 1, the applicant argues that there is no teaching or suggestion that the bank terminal is a financial transaction processing computer system. The applicant's invention is not performing a financial function; rather it is checking eligibility as no payments are being exchanged thereby rendering the applicant's argument non-persuasive. Freeman et al. discloses a computer system that receives a patient

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identification number/code through a credit card type machine, verifies (searches) for patient eligibility and financial status, and transmits the information to the physician (column 7, lines 20 -25, column 7, line 64 through column 8, line 7, and column 7, lines 21 – 26).

In regard to claim 2, the applicant argues that the cited references do not teach or suggest wherein the financial transaction processing computer system comprises a credit card processing system. However, Freeman et al. states that the physician may 'swipe' a patient's card using a credit card machine, which in turn contacts the bank to determine if sufficient funds are available thereby rendering the applicant's argument non-persuasive. Freeman et al. teaches a financial bank terminal, in which electronic funds are transferred from the bank to the physician provided sufficient funds are available (column 8, lines 26 – 28).

In regard to claim 5, the applicant argues that the cited references do not teach or suggest that the "individual code is received in a format relating to currency". As stated in the rejection of claim 5, the examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention. Although Freeman et al. does not expressly show individual codes in a currency format, the difference can only be found in the non-functional descriptive material and is not



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functionally involved in receiving individual codes. The process of receiving a code would be the same regardless of the format.

In regard to claim 12, the applicant argues that the cited references do not teach or suggest that the "individual code is received in a format relating to currency". As stated in the rejection of claim 12, the examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention. Although Freeman et al. does not expressly show individual codes in a currency format, the difference can only be found in the non-functional descriptive material and is not functionally involved in receiving individual codes. The process of receiving a code would be the same regardless of the format.

In regard to claim 17, the applicant argues that the cited references do not teach or suggest "an account number in credit card format" and "a list of covered members." The applicant cites Figure 2 of Pritchard as teaching away from the invention, however, Figure 2 does show a number in a credit card number format since a credit card number format can be any combination of numbers printed or embossed onto a credit card.

In addition, Doyle et al. teaches a list of covered members of an insurance plan. The list of covered members is displayed using a computer terminal when the insurance card is swiped through a credit card processing machine. Doyle et al. does not explicitly

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teach a listing of covered members on an insurance card, however Doyle et al. discloses an insurance card in which the main policy holder's name is listed. It would be obvious to include the covered members of the policy on the insurance card since it does not change the function of the insurance card, the insurance card would function in the same manner regardless of the names listed (Doyle et al.: column 2, lines 4 - 10).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-3776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

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A handwritten signature in black ink, appearing to read 'C. Luke Gilligan', is positioned above the printed name.

C. LUKE GILLIGAN  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600